

REMARKS

Claims remaining in the present patent application are Claims 1 – 24. Applicants respectfully request reconsideration of the above captioned patent application in light of the following remarks.

Prior Art

Applicants are confused by section 4.10 of the rejection, which states, “the current set of prior art consisting of Yeung (6,643,702), Bastiani (6,636,922), Takabatake (6,728,244) and Lappetelainen (6,693,915)....”

These four references have not been previously cited. The present rejection does not include a Form PTO-892 “Notice of References Cited,” and consequently these references are not cited thereon.

Applicants respectfully assert that none of these references appear relevant to the present claimed invention. For example, Yeung is directed to a “Traffic scheduler for a first tier switch of a two tier switch.” As these references are not cited in the rejections and do not appear to be relevant, Applicants will ignore these references until and unless their intended usage is clarified.

35 U.S.C. § 112

Claims 1, 12 and 21 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The rejection does not specify the subject matter that the rejection alleges was not present at the time the application was filed. However, elsewhere the rejection refers to the limitation “while providing access to other handheld devices for said information” presented in Applicants’ response of February 21, 2006. Applicants assume the present rejection refers to this limitation.

Applicants respectfully traverse the rejection of Claims 1, 12 and 21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully assert that the subject matter “while providing access to other handheld devices for said information” was included in the original disclosure of the present application.

For example, at page 20 line 1, the present application discloses:

Figure 6A illustrates a system 400a in accordance with an embodiment of the present invention for performing web file sharing between **two or more** handheld devices 100a and 100b, e.g., portable computer systems, using a remote server 410 acting as an intermediary to facilitate the transaction. In this example, the sending device is 100a and the receiver

device is 100b, but either device is capable of both sending and receiving in accordance with the descriptions herein. As described in more detail below, **multiple handheld devices** can register with the server 410 to perform synchronization, file sharing and file transfer procedures.
(emphasis added)

Applicants respectfully assert that this passage, *inter alia*, along with the drawings, contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Applicants respectfully assert that the claims as amended are fully supported by the application as originally filed, and respectfully solicit withdrawal of the rejections under 35 U.S.C. § 112, first paragraph.

35 U.S.C. § 251

Claims 1, 12 and 21 are rejected under 35 U.S.C. § 251 as being based upon new matter added to the patent for which reissue is sought.

Applicants traverse. The above captioned case is not a reissue application. As such, 35 U.S.C. § 251 does not apply. The Examiner is respectfully requested to withdraw this rejection.

Present Rejections

Applicants' response to the present rejection under 35 USC § 103 appears after Applicants' response to the Examiner's "Response to Arguments," below.

Response to Arguments

The rejection proposes to refute Applicants' argument that "Hoguta is completely silent as to synchronization." The rejection argues that Hoguta discloses a "transfer of information" between network-connected systems. Even if, *arguendo*, Hoguta discloses a "transfer of information" between network-connected systems, such disclosure fails to teach or fairly suggest "synchronization." As understood by those of ordinary skill in the art, synchronization requires more than a mere "transfer of information." For example, synchronization requires a determination of which dataset is most current. Applicants reiterate that Hoguta is completely silent as to synchronization.

The rejection proposes that, because Applicants use the term “fairly suggest,” the subject matter must therefore be suggested. Specifically, the rejection quotes Applicants’ remarks in the response of August 2, 2006, “Multer does not teach or fairly suggest modifying an account to identify information ‘not on said second handheld device’ as recited by Claim 1.” The rejection goes on to argue that use of the term “fairly suggest” is in some manner a concession that Multer does suggest such modification “to some degree.” The rejection then states, “Examiner must assume these action are taught in the prior art.”

Applicants deny that the use of the term “fairly suggest” is in any manner a concession. A suggestion, e.g., a suggestion to combine, may be made for any number of reasons. Indeed, the present response and the response of August 2, 2006 argue that the suggestion to combine Multer in view of Hoguta is based on impermissible hindsight.

However, the MPEP and a large body of case law makes clear that a suggestion may not be made for improper reasons. Rather, there must be a fair basis for the suggestion. Consequently, Applicants’ use of the term “fairly suggest” indicates that Applicants make such a statement based upon a higher standard of practice than represented by a mere suggestion without valid support.

Applicants reiterate that Multer does not teach or fairly suggest modifying an account to identify information “not on said second handheld device” as recited by Claim 1.

Further with respect to this portion of the “Response to Arguments,” Applicants respectfully assert that it is improper for the Examiner to “assume these actions are taught in the prior art.” Applicants assert that a rejection should be based upon facts supported by cited art, not assumptions.

The rejection proposes that the “information maintained for Applicant’s invention and the referenced prior art (Multer) are equivalent.” Applicants traverse. As previously presented and repeated herein, there is a fundamental difference between the taught “information store is maintained on a user-by-user basis” (column 17 lines 18-20, emphasis added) and the recited limitation recited “account reserved for a... device” as recited by Claims 1, 12 and 21.

Applicants assert that the taught “user” represents a person, whereas the recited “device” represents a device. As taught by Multer, “an authentication module specifically associating the user data with a particular user” (Claim 24, *inter alia*, emphasis added). Further, the taught “synchronization system is useful for maintaining matching records and data for a user across multiple network coupled devices” (column 3 lines 34-40, emphasis added). Thus, Multer

teaches maintaining an information store covering multiple devices on a user-by-user basis. In contrast, Claims 1, 12 and 21 recite an “account reserved for a... device.”

The rejection further argues that “there is no fundamental difference between a user or a device.” Applicants traverse. At a minimum, a user may have multiple devices. A device is one device. Consequently, accounting and/or tracking information on a user-by-user basis, as taught by Multer, is fundamentally different from accounting for information on a device-by-device basis, as recited by the instant claims.

Applicants traverse the rejection’s assertion that the “information maintained for Applicant’s invention and the referenced prior art (Multer) are equivalent,” and reiterate that, as devices are not equivalent to people, accounting based on a device is not equivalent to accounting based on a user basis, which may include multiple, disparate devices.

The rejection alleges that “Applicant argues that the referenced prior art does not disclose “...storage of ‘a user’s entire file system tree.’” The rejection is unclear as to the relevance of this statement.

The rejection mischaracterizes Applicants' previous statement of August 2, 2006. Applicants have not argued that Multer "does not disclose "...storage of 'a user's entire file system tree.'"" Rather, Applicants were citing to a teaching of Multer. The salient portion of Applicants response of August 2, 2006 is reproduced below for convenience:

In addition with respect to Claim 1, Applicants respectfully assert that Multer teaches away from the claim limitation of "describing a complement of information stored in said second handheld device" as recited by Claim 1. As recited, embodiments of the present invention in accordance with Claim 1 describe information that is not stored in said second handheld device. In contrast, Multer teaches storage of "a user's entire file system tree" (column 33, line 4, *inter alia*). By teaching storage of all of a user's data, including data that may be stored on the remote device, Multer actually teaches away from the recited limitation of storing a "complement of information stored in said second handheld device" as recited by Claim 1.

The teaching of storing an entire file system is relevant as Multer teaches away from the limitation of "describing a complement of information stored in said second handheld device" as recited by Claim 1. As is known by those of skill in the art, the recited complement of information stored refers to a limited portion of the total information, e.g., that information that is not stored in the second device. From set theory, a complement is the set of all elements in the

set that are not in a specified subset. Moreover, the recited complement of information stored specifically excludes the information already stored.

In contrast, Multer teaches storing all of the information. Storing all of the information is fundamentally different from storing a portion of the information and excluding another portion of the information. In teaching storing all of the information, Multer actually teaches away from embodiments in accordance with the present invention that recite not storing all of the information, as recited by Claim 1.

For example, consider the set I consists of non-overlapping subsets A and B. A is the complement of B. Multer teaches storing A and B, e.g., the entire set I. Claim 1 recites describing A and not B.

Per *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S.851 (1984), “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” Consequently, as Multer teaches away from embodiments in accordance with the present invention that recite not storing all of the information, the rejection is improper.

The rejection proposes that Multer discloses the limitation “a complement of information stored in said second handheld device” as recited by Claim 1. In making the argument, the rejection proposes that the term “complement” is equivalent to “a set.” Applicants traverse. For example, Wikipedia defines complement as “[i]n many different fields, the complement of X is something that together with X makes a complete whole, something that supplies what X lacks.” Further, from set theory, a complement is the set of all elements in the set that are not in a specified subset. Applicants assert that the term “complement” is not equivalent to “a set.”

The rejection proposes, “[i]t is not a requirement to disclose a token, when the prior art named entity, the datapack, performs an equivalent function.” The rejection further refers to a portion of Applicants’ response stating that “Multer does not even utilize the word ‘token’ or similar terms,” as if this were the foundation of Applicants’ argument.

The rejection apparently ignores Applicants’ argument that Multer’s “datapack” is not equivalent to the recited “token.” Multer teaches that a datapack is “a compacted and encrypted Change Log” (column 16 line 43). In contrast, the recited “token” identifies a specific set of information and causes an account to be modified. Applicants respectfully assert that a change log (Multer’s “datapack”) cannot cause the change that it records. For example,

before there are changes, there is no log of such changes. If there is no log, such a non-existent log cannot cause changes to occur. Consequently, Multer's "datapack" cannot be the recited "token."

Applicants respectfully assert that the entirety of Multer is silent as to the recited "token."

The response of August 2, 2006 argued that Multer does not teach or fairly suggest the claim limitation of "wherein said information is a version of an application program" as recited by Claim 4. The rejection proposes to refute this argument by reference to Multer's "version number" and "each application has an application object."

With respect to the taught "version number," Multer teaches, "a versioning module... applies a version number per object in the data package" (column 12 lines 10-12). A data package "describes changes to any and all transfer information" (column 10 lines 26-31). Thus, the taught version number applies to information describing changes. Multer in its entirety fails to teach a version number applied to an application program.

With respect to the taught "application object," Multer teaches:

The application object is specific to each particular application 810 and provides a standard interface between the device engine and the balance of the data transmission system of the invention, and the application 810. Details of the application object will be described in further detail below. The application object is a pluggable architecture which supports a wide variety of vendor-unique applications. The job of the application object is to map data from the application into a temporary or "universal" data structure by connecting to the application via any number of standard interfaces to gain access to the applications data. (column 11 lines 12-27)

Thus, an application object maps data from an application's internal format to a universal data structure. Further, an application object is not an application program.

Neither Multer's "version number" nor the teaching "each application has an application object" bear any relevance to the recited limitation "wherein said information is a version of an application program" as recited by Claim 4. Multer does not teach or fairly suggest transferring a new version of an application program within the taught synchronization.

35 U.S.C. § 103

Claims 1-24 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Multer et al. (US# 6,757,696 B2, "Multer") in view of Hoguta et al. (US 6,725,303, "Hoguta"). Applicants have carefully reviewed the cited

references and respectfully assert that embodiments of the present invention as recited in Claims 1-24 are patentable over Multer in view of Hoguta.

Applicants respectfully assert that the rejection's citation of Hoguta is improper because the reference is nonanalogous art per *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). Applicants understand Hoguta to be directed to personalizing a network connection, classified in Class 710/106, "Electrical Computers and Digital Data Processing Systems: Input/Output - Using transmitter and receiver," whereas embodiments in accordance with the present claimed invention, as well as the primary reference Multer, are directed to synchronization of data sets.

Applicants respectfully assert that Hoguta would not commend itself to one of ordinary skill in the art in consideration of the problems solved by the present invention, due to the myriad well known differences between data set synchronization and network access. Further, Applicants respectfully assert that Hoguta would not commend itself to one of ordinary skill in the art for combination with Multer, for a similar rationale.

For these reasons, Applicants respectfully assert that all rejections based upon a combination of Multer in view of Hoguta are overcome, and respectfully solicit allowance of Claims 1-24.

Further, the rejection proposes, as motivation for the proposed combination, to employ Hoguta “in order to enable uniform customization of services based on profile and preferences information.” Assuming, *arguendo*, that synchronization is fairly considered a service, Applicants do not find Hoguta to teach that synchronization, the subject of Multer, may benefit from “uniform customization.” Applicants respectfully assert that Hoguta is completely silent as to synchronization.

Applicants respectfully assert that the rejection applies impermissible hindsight to fabricate a motivation for the proposed combination. Applicants respectfully assert that the proposed motivation for the cited combination is not found in the art of record.

For this further reason, Applicants respectfully assert that all rejections based upon a combination of Multer in view of Hoguta are overcome, and respectfully solicit allowance of Claims 1-24.

Such impermissible hindsight is further demonstrated in the rejection’s summary of a claimed limitation found on page 5 of the rejection, “the capability to enable access to user profile by another user.” Claim 1 does not recite the terms “user” or “profile.” In fact, this and previous responses argue

fundamental differences between the taught “user” and the recited “device.” In formulating an argument based upon these terms, the rejection demonstrates a bias for interpreting the recited Claims in the language of the cited art, rather than the language in which the Claims are recited.

For this further yet reason, Applicants respectfully assert that all rejections based upon a combination of Multer in view of Hoguta are overcome, and respectfully solicit allowance of Claims 1-24.

With respect to Claim 1, Applicants respectfully assert that Multer teaches away from the claim limitation of an “account (stored on a remote server) reserved for a second handheld device” as recited by Claim 1.

As taught by Multer in column 17 lines 18-20, *inter alia*, an “information store is maintained on a user-by-user basis” (emphasis added). The rejection itself characterizes Multer as teaching “user accounting information for each user” (page 4 “regarding Claim 1,” emphasis added).

Applicants respectfully assert that one of ordinary skill in the art would understand that there is a fundamental difference between the taught user-centric information and the recited “account reserved for a... device.” For example, a user can have multiple devices capable of synchronization, e.g.,

mobile phone, MP3 player, personal digital assistant, etc. As taught by Multer, information is stored on a user basis. In contrast, the instant limitation recites an account on a device basis.

Consequently, the fundamental organization and principles of operation of Multer teach away from embodiments of the present invention that recite information storage and/or accounting on a device basis, as recited by Claim 1.

For this reason, Applicants respectfully assert that Claim 1 overcomes the rejection of record, and respectfully solicit allowance of this Claim.

Further with respect to Claim 1, Multer teaches, “the storage server will be checked to determine whether a new version of the data exists on the storage server (column 34, lines 24-26). In other words, Multer teaches determining the possible existence of new information as a part of the synchronization process.

In contrast, Claim 1 recites that such new information, “a complement of information stored in said second handheld device,” is stored on a server. By teaching determining the existence of new information is a part of the synchronization process, Multer teaches away from the recited “storing... a complement of information” as recited by Claim 1.

For this further reason, Applicants respectfully assert that Claim 1 overcomes the rejection of record, and respectfully solicit allowance of this Claim.

In addition with respect to Claim 1, Applicants respectfully assert that Multer teaches away from the claim limitation of “describing a complement of information stored in said second handheld device” as recited by Claim 1. As recited, embodiments of the present invention in accordance with Claim 1 describe information that is not stored in said second handheld device. In contrast, Multer teaches storage of “a user’s entire file system tree” (column 33, line 4, *inter alia*). By teaching storage of all of a user’s data, including data that may be stored on the remote device, Multer actually teaches away from the recited limitation of storing a “complement of information stored in said second handheld device” as recited by Claim 1.

For this additional reason, Applicants respectfully assert that Claim 1 overcomes the rejection of record, and respectfully solicit allowance of this Claim.

Still further with respect to Claim 1, Applicants respectfully assert that Multer teaches away from the claim limitation of an “account modified to identify an information that resides on said remote server but not on said

second handheld device” as recited by Claim 1. For example, Multer teaches, “(after a device connects) the storage server will be checked to determine whether a new version of the data exists on the storage server” (column 34 lines 23-26). Thus, in contrast to the recited limitation of Claim 1, the system of Multer does not know whether information resides on a device until the device connects to the server. Thus, Multer does not teach or fairly suggest modifying an account to identify information “not on said second handheld device” as recited by Claim 1.

For this still further reason, Applicants respectfully assert that Claim 1 overcomes the rejection of record, and respectfully solicit allowance of this Claim.

Further still with respect to Claim 1, Applicants respectfully assert that Multer does not teach or fairly suggest the claim limitation of “describing a complement of information stored in said second handheld device” as recited by Claim 1. As described previously, and as recognized by the rejection, Multer operates on a user basis. Consequently, Multer fails to teach or fairly suggest the recited device of the instant limitation.

Hoguta is not alleged to correct this deficiency of Multer, and Applicants respectfully further assert that Hoguta does not correct this deficiency of

Multer. For this rationale, Applicants respectfully assert that Claim 1 overcomes the rejection of record, and respectfully solicit allowance of this Claim.

Still yet further with respect to Claim 1, Applicants respectfully assert that Multer in view of Hoguta does not teach or fairly suggest the claim limitation of:

said remote server automatically determining from said account that said information is new to said second handheld device, and in response thereto automatically downloading said information to said second handheld device

as recited by Claim 1. In contrast, Multer teaches a conventional synchronization in which device data is compared to a user's complete data set to determine any new information. Consequently, Multer teaches determining that information is new based upon interaction with the (second) device, in contrast to the recited "determining, from said account."

Hoguta is not alleged to correct this deficiency of Multer, and Applicants respectfully further assert that Hoguta does not correct this deficiency of Multer. For this still yet further reason, Applicants respectfully assert that

Claim 1 overcomes the rejection of record, and respectfully solicit allowance of this Claim.

In addition with respect to Claim 1, Applicants respectfully assert that Multer in view of Hoguta does not teach or fairly suggest the claim limitation “while providing access to other handheld devices for said information” as recited by Claim 1.

The rejection proposes that Multer in view of Hoguta would “enable access to profile information by a user of a network.” While it may be possible to modify Multer in such a manner, Applicants respectfully assert that such modification, *even if possible and proper*, fails to teach or fairly suggest the instant limitation.

Hoguta teaches profile information includes:

subscriber preferences and service entitlements related to long distance, local or wireless phone calling plans (e.g., rates and peak/off-peak hours, calling circles), communication link attributes (e.g., speed, guaranteed information rate), television programming (e.g., premium encrypted or basic unencrypted programs, programming genres, program time-shifting), information resources, the type of network the user wishes to use, communication protocols corresponding to particular networks,

multimedia content access (e.g., Internet or intranet site access, software downloads) and any rights to copy such content (column 2 lines 32-44)

Neither the above-cited portion of Hoguta, nor Hoguta in its entirety, teach or fairly suggest that “profile” information may comprise the recited “information that resides on said remote sever but not on said second handheld device”.

While Hoguta may teach that a profile comprises some manner of “information,” such information is clearly not the claimed information as recited by Claim 1.

Consequently, *even if* the proposed modification of Multer in view of Hoguta enables “access to profile information by a user of a network,” such new function fails to teach or fairly suggest the claimed limitation “while providing access to other handheld devices for said information” as recited by Claim 1.

For this additional reason, Applicants respectfully assert that Claim 1 overcomes the rejection of record, and respectfully solicit allowance of this Claim.

Claims 2-11 depend from Claim 1. Applicants respectfully assert that these Claims overcome the rejections of record as they depend from an allowable base claim, and respectfully solicit allowance of these Claims.

With respect to Claim 2, Applicants respectfully assert that Multer does not teach or fairly suggest the claim limitation of “said first handheld device sending said remote server a token identifying said information and said second handheld and wherein said token causes said account to be modified by said remote server” as recited by Claim 2. Applicants respectfully assert that Multer does not even utilize the word “token” or similar terms. Applicant respectfully asserts that the rejection improperly equates Multer’s “datapack” with the recited token. Multer teaches that a datapack is “a compacted and encrypted Change Log” (column 16 line 43). Applicants respectfully assert that one of ordinary skill in the art would understand a fundamental difference between the recited “token” and the taught “change log.”

For this additional reason, Applicants respectfully assert that Claim 2 overcomes the rejection of record, and respectfully solicit allowance of this Claim.

Further with respect to Claim 2, the rejection asserts that Multer column 37, lines 62-65 teaches the recited “token.” Applicants respectfully traverse. The cited portion of Multer teaches, “[a] DataPack essentially contains a sequence of transactions describing changes to information.” Applicants respectfully assert that this cited teaching as well as the whole of Multer fails to teach or fairly suggest the recited token that identifies said second handheld

and causes said account to be modified. Multer is completely silent as to these recited attributes of a token.

For this further reason, Applicants respectfully assert that Claim 2 overcomes the rejection of record, and respectfully solicit allowance of this Claim.

With respect to Claim 4, Applicants respectfully assert that Multer does not teach or fairly suggest the claim limitation of “wherein said information is a version of an application program” as recited by Claim 4. Applicants respectfully assert that Multer is silent as to synchronization of Application programs. Applicant respectfully asserts that the rejection improperly equates Multer’s “versioning module” with the recited “application program.” Multer teaches, “a versioning module... applies a version number per object in the data package” (column 12 lines 10-12). Applicants respectfully assert that the taught applying a version number fails to teach or fairly suggest the recited “application program” to one of ordinary skill in the art.

For this additional reason, Applicants respectfully assert that Claim 4 overcomes the rejection of record, and respectfully solicit allowance of this Claim.

With respect to Claim 12, Applicants respectfully assert that Claim 12 overcomes the rejections of record for at least the rationale presented previously with respect to Claim 1. For these reasons, Applicants respectfully solicit allowance of this Claim.

Claims 13-20 depend from Claim 12. Applicants respectfully assert that these Claims overcome the rejections of record as they depend from an allowable base claim, and respectfully solicit allowance of these Claims.

With respect to Claim 13, Applicants respectfully assert that Claim 13 overcomes the rejections of record for at least the rationale presented previously with respect to Claim 2. For this additional reason, Applicants respectfully solicit allowance of this Claim.

With respect to Claim 15, Applicants respectfully assert that Claim 15 overcomes the rejections of record for at least the rationale presented previously with respect to Claim 4. For this additional reason, Applicants respectfully solicit allowance of this Claim.

With respect to Claim 21, Applicants respectfully assert that Claim 21 overcomes the rejections of record for at least the rationale presented previously

with respect to Claim 1. For these reasons, Applicants respectfully solicit allowance of this Claim.

Claims 22-24 depend from Claim 21. Applicants respectfully assert that these Claims overcome the rejections of record as they depend from an allowable base claim, and respectfully solicit allowance of these Claims.

CONCLUSION

Claims remaining in the present patent application are Claims 1 – 24. Applicants respectfully request reconsideration of the above captioned patent application in light of the remarks presented herein.

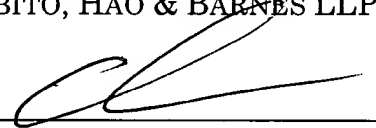
The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Please charge any additional fees or apply any credits to our PTO deposit account number: 23-0085.

Date: 4/2/2007

Respectfully submitted,

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